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REMARKS

The present application includes claims 1-60. Claim 3 was amended. Claims 29-31, 33-36, and 57-60 were withdrawn from consideration. The applicant reserves the right to file a divisional application with claims 57-60 at a later date.

The drawings are objected to under 37 CFR 1.83(a), as not showing the "means for affixing" of claim 51. The "means for affixing the apparatus to a vertebra" is bone rest 330, shown in Fig. 8A. As described on page 18, lines 31-34, there are several ways that bone rest 330 can affix the apparatus to the spine. Retractable spikes can be used, or bone rest 330 can be shaped to match the anatomy of the spine.

Claim 28 stands rejected under 35 USC §112 first paragraph, as lacking support, since the application does not suggest any bioabsorbable material which could be used. Although the applicant cited US patent 6,015,410 as describing suitable bioabsorbable materials, the Examiner states that the requirements for a rasp and a generic implant are different, and that the materials described in US patent 6,015,410 are not necessarily usable for a rasp. The applicant respectively traverses the rejection, and notes that these bioabsorbable materials are described as being "stiff and tough" and having tensile strength between 400 and 2000 MPa, in column 8, lines 24-27 of US patent 6,015,410. This range of tensile strengths largely overlaps the range of tensile strengths for tool steel, a material often used for rasps. For example, <http://www.matweb.com> lists the tensile strengths of a large variety of tool steels, and the great majority are between 1000 and 2000 MPa. Bone has a much lower tensile strength, about 90 MPa to 120 MPa, based on a table (in English units) in the 1918 edition of Gray's Anatomy, Sec. II.2, paragraph 2, available online at <http://www.bartleby.com>. Therefore, these bioabsorbable materials would be usable for a rasp to be used on bone, as would be known to a person skilled in the art.

Claims 1-27, 32, 37, 39, 40-42, and 44-50 stand rejected under 35 USC §103(a) as being unpatentable over US patent 2,372,553 to Coddington. Claims 52-54 stand rejected under 35 USC §103(a) as being unpatentable over Coddington in view of US patent 3,523,348 to Nilsson. Claims 43-46 stand rejected under 35 USC §103(a) as being unpatentable over Coddington in view of US patent 2,355,124 to Testo. Claim 38 stands rejected under 35 USC §103(a) as being unpatentable over Coddington in view of US patent 5,713,785 to Nishio. The applicant respectfully traverses these rejections, and submits that there is not a *prima facie* case of obviousness for any of these claims.

Claim 1 has the limitation that the flexible rasp is adapted for passage through a spinal

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channel of a live human. The Examiner states that the continuous band 10 shown in Fig. 5 of Coddington could be inserted through a spinal channel of a live human, if the band were cut and then reassembled, and states that a person skilled in the art might have been motivated to make such a modification in the band, in order to remove the band from wheels 13, and to replace the band. However, it is known that in band saws such as that shown in Fig. 5 of Coddington, there is a mechanism for moving one of the wheels closer to the other wheel, in order to relieve the tension on the band, so that the band can be removed and replaced. If such a mechanism is present, there would be no advantage to cutting the band and reassembling it, when replacing it. If such a mechanism were not present, then cutting the band would not make it possible to replace the band, since, with the tension of the band relieved, it would not be quite long enough to be reassembled, and there would be no easy way to put the band under tension before it is reassembled and mounted on the wheels.

Furthermore, making the band splittable would be expected to weaken it, to make it non-uniform at the location where it is splittable, and to make it more expensive and difficult to manufacture. Coddington teaches away from making any modification to the band which would shorten its lifetime by weakening its strength and structural integrity, make it non-uniform, or make it more expensive or difficult to manufacture. On page 1, left column, lines 16-17, Coddington states that an advantage of his invention is that the band has a "long flexing and cutting life," and is "relatively inexpensive" compared to the prior art, which is described on lines 28-29 as "difficult and expensive to produce." On lines 53-54, he states that the band has "a uniform unbroken filing surface," in contrast to the prior art, described on lines 33-34 as having "essential breaks in the filing surface." On page 2, left column, line 12, the band is described as being preferably made of "high speed tool steel," indicating that the band is designed to be run at high speed, so the structural integrity of the band is important to ensure that it has a long life. On page 2, right column, lines 19-21, Coddington states that "fracturing the underlying the metal of the band would greatly shorten the life of the unit," showing the importance of making the band strong. All of these advantages would be undone if the suggestion of the Examiner were followed. Thus, making these changes, *even if they resulted in the present claimed invention* (which applicant denies) would not be *prima facie* obvious.

Applicant submits that even were the changes made, the limitations of claim 1 would still not be present. Claim 1 requires that the flexible rasp be *adapted* for passage through a spinal channel. Breaking and re-welding of the band does not constitute any kind of adaptation in the

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apparatus, as is required to meet the limitations of the claim.

If claim 1 is patentable, then the other claims are patentable at least by virtue of their dependence on claim 1. In addition, there are other reasons for patentability, in the case of at least some of the dependent claims. In the case of claim 4, the Examiner states that the item labeled 15 in Fig. 5 of Coddington can be considered the shield. However, item 15 in Fig. 5 is a water tank, and is not a part of the band saw at all, but is used during the manufacture of the band, to rapidly quench the teeth after they have been flame hardened by flame X. For the same reason, tank 15 cannot be considered the "source of cleaning fluid" described in claim 37.

Claim 3 has been amended, correcting a typographic error, replacing "pick-up reel" with "take-up reel." This supported, for example, by page 19, lines 15-16, which refer to "take-up reel 324" in Fig. 8A. The Examiner states that the central portions of extensions 13 in Fig. 5 of Coddington can comprise the "pick reel," presumably referring to the "pick-up reel" in the original claim 3. The applicant believes that the Examiner may have been confused by the typographic error in claim 3, and thought that one or both of wheels 13 in Fig. 5 of Coddington might be considered as a "pick-up reel," a term not listed in the dictionary. With the error in claim 3 corrected, it is clear that the "take-up reel" cannot be construed to be one of wheels 13 in Fig. 5 of Coddington, but is a reel that takes up one end of a rasp which does not form a closed loop, as shown in Figs. 2 and 8A of the present application.

Fig. 8A has been amended to correct a typographic error, replacing the label 324 near the bottom of the drawing with a label 332. As described on page 19, line 6, label 332 indicates a sensor, provided to determine proper contact between bone rest 330 and the spine. There is already another label 324 on Fig. 8A, in the upper right part of the drawing, indicating a take-up reel, as described on page 19, lines 12-13.

In view of the above remarks, applicant submits that the claims are patentable over the prior art. If the Examiner does not agree regarding one or more of the claims, but is of the opinion that a telephone conversation may forward the present application toward allowance, applicant respectfully requests that the Examiner call the undersigned at 1 (877) 428-5468. Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington.

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Respectfully submitted,
Assaf DEKEL

A handwritten signature in cursive script, reading "Michael Gerver".

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